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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,494	11/02/2000	Timothy Samuel Girton	760-35	4895

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EXAMINER

MILLER, CHERYL L

ART UNIT PAPER NUMBER

3738

DATE MAILED: 12/29/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,494

Applicant(s)

GIRTON, TIMOTHY SAMUEL

Examiner

Cheryl Miller

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003 and 09 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-11 and 18 is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 16, 2003 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 14 recites, "polytetrafluoroethylene lacks node and fibril structure", which does not further limit claim 13, which also claims PTFE without a node and fibril structure.

A note to the applicant: claims 1, 4-6, and 17 are product by process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made

by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

See MPEP 2113. Therefore, the process steps of these claims have not been examined, since the end product of the references used in the below rejection is the same as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCollam et al. (USPN 6,143,675, cited in previous office action) in view of Dereume et al. (USPN 5,639,278, cited in previous office action). Referring to claims 1-6 and 13-17, McCollam discloses an endoprosthesis (medical field col.1, lines 7-8; col.4, lines 45-49) comprising a cover (2) formed of a porous PTFE having voids intermeshed between pockets of PTFE without a node and fibril structure (non expanded, sintered PTFE, col.2, lines 55-56; col.2 line 65-col.3 line7; TEFLON col.7, lines 51-60). McCollam discloses use of the endoprosthesis in the medical field for blood passageways and veins (col.4, lines 45-49), wherein the cover is supported by a wire mesh (col.4, lines 18-23), however does not expressly disclose the wire mesh support structure as an expandable tubular stent. Dereume teaches combining a radially expandable stent (22) in between two radially expandable covers (grafts 23, 24), in order to provide increased support, enhanced tissue ingrowth, and means to cover an aneurysm in an artery or vein (col.2, line 64-col.3, line 4; col.3, lines 20-30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Dereume's

teaching of combining a radially expandable stent in between two covers, with McCollam's type of cover made of porous PTFE having no node and fibril structure, in order to provide an endoprosthesis that supports an artery or vein, covers an aneurysm, enhances tissue ingrowth, etc. enhancing the overall biocompatibility of the prosthesis.

Claims 1-6 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinchuk (USPN 4,657,544, cited by applicant in IDS) in view of Dereume et al. (USPN 5,639,278, cited in previous office action). Referring to claims 1-6 and 13-17, Pinchuk discloses an endoprosthesis device (col.3, lines 16-18) comprising a cover (10) formed of a porous PTFE (col.4, lines 4-13; col.5, lines 35-37) having voids (16) intermeshed between pockets of PTFE without a node and fibril structure (has not been stretched, and is TEFLON, so no nodes or fibrils). Pinchuk discloses use of a graft cover endoprosthesis used for arteries and veins, however does not disclose the use of a radially expandable stent. Dereume teaches combining a radially expandable stent (22) in between two radially expandable covers (grafts 23, 24), in order to provide increased support, enhanced tissue ingrowth, and means to cover an aneurysm in an artery or vein (col.2, line 64-col.3, line 4; col.3, lines 20-30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Dereume's teaching of combining a radially expandable stent in between two covers, with McCollam's type of cover made of porous PTFE having no node and fibril structure, in order to provide an endoprosthesis that supports an artery or vein, covers an aneurysm, enhances tissue ingrowth, etc. enhancing the overall biocompatibility of the prosthesis.

Allowable Subject Matter

Claims 7-11 and 18 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Cheryl Miller



BRUCE SNOW
PRIMARY EXAMINER